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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,950	09/26/2003	Alexander Alanine	21004US1	9408

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HOFFMANN-LA ROCHE INC.  
PATENT LAW DEPARTMENT  
340 KINGSLAND STREET  
NUTLEY, NJ 07110

EXAMINER

DENTZ, BERNARD I

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/672,950

Applicant(s)

ALANINE ET AL.

Examiner

Bernard Dentz

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,12,13,17-20 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6 and 16 is/are rejected.
- 7) ☒ Claim(s) 1,4,5,7-11,14,15 and 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 10/277,002.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12-18-2003</u> . | 6) <input type="checkbox"/> Other: ____.  |

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3 and 14-18, drawn to compounds of IA wherein 1 or 2 of R1 and R2 contains amino and the dotted line represents 2H, classified in class 546, subclass 311 e.g.
- II. Claims 1,4-11,14-16 and 21, drawn to compounds of IA where 1 or 2 of R1 and R2 contains amino and the dotted line represents a bridge, classified in class 546, subclass 281.1 e.g.
- III. Claims 1, 12-16, 19 and 20, drawn to compounds of IB where 1 or 2 of R1 and R2 contains amino and the dotted line represents 2H, classified in class 546, subclass 329.
- IV. Claims 1,14,15 and 22, drawn to compounds of IB where 1 or 2 of R1 and R2 contains amino and the dotted line represents a bridge, classified in class 546, subclass 304 e.g.

The next 4 Groups below simply track the above 4 with the distinguishing feature being that neither R1 and R2 are amino containing groups.

- V. Claims 1,2,15 and 16, drawn to the remaining compounds of IA where the dotted line represents 2H, classified in class 546, subclass 344 e.g.
- VI. Claims 1,4,5,7,9,10,16 and 21, drawn to the remaining compounds of IA where the dotted line represents a bridge, classified in class 546, subclass 339 e.g.
- VII. Claims 1,12,15 and 16, drawn to the remaining compounds of IB where the dotted line represents 2H, classified in class 546, subclass 350.

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IX. Claims 1,14-16 and 22 , drawn to the remaining compounds of IB where the dotted line represents a bridge, classified in class 546, subclass 346.

The inventions are distinct, each from the other because:

The subject matter encompassed by claim 1 is drawn to a genus of compounds the 2- or 4- position by an unsaturated group which is part of a chain or ring. It may or may not be substituted by 1 to 2 members of a group selected from alkyl, an amino or hydroxyl containing group.

It contains much patentably distinct subject matter and is classified in many places as shown above.

During a telephone conversation with Ms. Prior on 4-12-2005 a provisional election was made with traverse to prosecute the invention of Gp. II, claims 1,4-11,14-16 and 21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 2,3,12,13,17-20 and 22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims 1,4,5,7,9,10,14, 15, 16 and 21 are objected to for misjoinder of invention for the above reasons.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, line 7 after "pyridin-4-yl" "J" should be deleted.

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In claim 6, line 8 "C-[" should be deleted.

In claim 6, line 8 after "pyridin-2-yl" "]" should be deleted.

These changes will correct an obvious error and remove unneeded parenthesis.

In claim 16, line 2 "such as" should be changed to - -selected from- -

Claims 6,8 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

.Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernard Dentz whose telephone number is 571-272-0683. The examiner can normally be reached on Mon-Fri from 8 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571 272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dentz  
4-14-2005

B Dentz

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GROUP 1625